REMARKS

Claims 14, 16, 18 and 21-25 are pending and stand ready for further action on the merits. Support for the amendment to claim 14 can be found in cancelled claim 3. Claim 18 has been amended for clarity. Support for claims 21-25 can be found in claims 5, 6, 8, 9 and 10, respectively. No new matter has been added by way of the above-amendment. In addition, new claims 21-25 simply repeat cancelled claims 5, 6 and 8-10 with the exception of being dependent on claim 14. As such, no new issues for consideration have been raised with these new claims.

[I] Interview

Applicants note with appreciation that Examiners Gollamudi and Dees conducted an interview with Applicants' representative on October 28, 2002 to discuss the merits of this case. Examiners Gollamudi and Dees were very helpful in clarifying the issues.

The following sections correspond to the sections of the outstanding Office Action.

[II] Issues Under 35 U.S.C. §112, second paragraph

Claims 9 stands rejected under 35 U.S.C. §112, second paragraph for being indefinite. In view of the cancellation of claim 9, Applicants respectfully submit that this rejection is rendered moot.

[III] Cited Art

[III-A] Advantages of the Present Invention

The present invention relates to a stable ointment containing Aspirin (acetyl salicylic acid). Aspirin is a well known pharmaceutical having anti-inflammatory, anti-pyretic and analgesic properties, and is generally administered orally in the form of tablets, granules, etc. However, due to the fact that Aspirin can have the deleterious side effect of irritating the intestines, its external application has been studied.

It is has been found that there is a problem with external preparations in that Aspirin is readily hydrolyzed even in the presence of a small amount of water. In addition, certain kinds of additives accelerate the hydrolysis of Aspirin.

The present inventors have intensively studied this problem and have sought a technique for insuring that the Aspirin is stable in ointments. The present inventors have surprisingly found that upon melting a base (such as Vaseline, Hydrocarbon

Gel or a mixture thereof) by warming, powders of Aspirin can be added thereto under stirring and mixed to prepare ointments which are stable to hydrolysis. It is this novel and non-obvious technique which provides a stable ointment containing Aspirin which distinguishes the present invention from the prior art.

We now turn to the cited references.

[III-B] JP 3-72426

Claims 1-6, 8-10 and 14-20 are rejected under 35 U.S.C. §102(b) as being anticipated by JP 3-72426, hereinafter JP '426. Applicants respectfully traverse the rejection.

As a first matter, the Examiner is requested to clarify for the record in the next communication that claims 1-6, 8-10 and 14-**20** are included in the rejection. At the top of page 3 of the outstanding Office Action, the Examiner indicates that claims 1-6, 8-10 and 14-**10** are included in the rejection.

As the Examiner will note, the only independent claim currently pending is claim 14. Claim 14 recites the transitional phrase "consisting of" which is the narrowest of transitional phrases.

Applicants respectfully submit that in view of the fact that claim 14 recites an ointment consisting of Aspirin and a

base (petrolatum, Hydrocarbon Gel or a mixture thereof), that claim 14 is not anticipated by JP '426.

JP '426 fails to anticipate the presently claimed ointment, since JP '426 requires an Aspirin solvent such as diethylene glycol monoethyl ether, etc. which is essential in the compositions of the reference (see English translation of JP '426 at page 5, lines 6-10). In addition, the compositions in all of the working examples in the reference contain such an Aspirin solvent.

Finally, the present invention is clearly superior to the invention disclosed by JP '426, because the present invention does not require an Aspirin solvent. In view of the above-amendments and remarks, Applicants respectfully submit that the presently claimed invention is not anticipated by JP '426 and withdrawal of the rejection is respectfully requested.

[III-C] Burton U.S. 4,012,508

Claims 1, 2, 8-10 and 14-20 are rejected under 35 U.S.C. §102(b) as being anticipated by Burton. Applicants respectfully traverse the rejection.

In view of the fact that claim 1 has been amended to recite the subject matter of claim 3, a claim not currently under

rejection, Applicants respectfully submit that this rejection is rendered moot.

[III-D] GB 2144326 (hereinafter GB '326)

Claims 1-6 and 14-20 are rejected under 35 U.S.C. §102(b) as being anticipated by GB '326. Applicants respectfully traverse the rejection.

GB '326 teaches an anhydrous pharmaceutical preparation for topical administration in the treatment of psoriasis, acne, seborrheic dermatitis, idiopathic vitiligo and bullous pemphigoid comprising, as the active ingredient, acetyl salicylic acid together with a suitable base. See page 1, lines 4-10.

As a suitable base, GB '326 teaches liquid paraffin, lanolin, white soft paraffin, white bees wax, hard paraffin and certain alcohols such as ethanol, propanol, isopropyl alcohol, glycerol and glycol and mixtures thereof. See page 1, lines 67-74.

Applicants respectfully submit that the presently claimed invention is patentably distinct from the teachings of GB '326, in that the present ointment contains a Hydrocarbon Gel and/or Vaseline as the base.

However, the Examiner appears to be taking the position that the hydrocarbons taught to be useful as a base by GB '326 are equivalent to the inventive "Hydrocarbon Gel." In order to clarify the scope of the term "Hydrocarbon Gel", Applicants have attached hereto as an appendix, pages 168-169 of Japanese Pharmaceutical Excipients (1993, edited by the Japanese Pharmaceutical Excipients Counsel). This reference teaches that the Hydrocarbon Gel is obtained by gelatinizing liquid paraffin with 5-10% polyethylene. Accordingly, the inventive "Hydrocarbon Gel" is known in the art to have a specific composition, which is neither taught nor suggested by GB '326.

In GB '326, soft white paraffin is always used with other ingredients such as hard paraffin/white bees wax (Example 1) or lanolin (Examples 2 and 4). In Example 1 of GB '326 an ointment comprising acetyl salicylic acid (12.5 grams), white bees wax, (1.75 grams), hard paraffin (7.0 grams) and white soft paraffin (78.75 grams) is disclosed. Thus, clearly none of these examples teach the use of a Hydrocarbon Gel, as is known in the pharmaceutical excipient art.

In addition, alcohols such as ethanol and isopropanol are used as an ingredient in examples 5 and 7 in GB '326. This is counter productive to the advantages of the inventive ointment, since alcohol is an additive which destroys the stability of

Aspirin (see page 4, lines 7-9 of the present specification). Thus, GB '326 does not place into the possession of the public the inventive ointment containing acetyl salicylic acid with a base selected from the group consisting of Hydrocarbon Gel, petrolatum and a mixture thereof as presently claimed, as is required under 35 USC 102(b), nor does GB '326 teach or suggest the superior effects of the present invention. As such, withdrawal of the anticipation rejection is respectfully requested.

[III-E] Burton and GB '326

Claims 3-6 are rejected under 35 U.S.C. §103(a) as being unpatentable over Burton in view of GB '326. Applicants respectfully traverse the rejection.

Applicants respectfully take the position that the ointment defined in independent claim 14 is distinct from the ointment of Burton, since: 1) the ointment of Burton requires a cortical steroid be placed with the aspirin, whereas independent claim 14 does not include a cortical steroid in view of the recitation of the transitional phrase "consisting of;" and 2) the only example of Burton which does not include the cortical steroid is Example 10, which includes Aspirin in a concentration well out of the inventive concentration range of about 0.001 to 30% by weight.

In Example 10 of Burton, the concentration of Aspirin is approximately 53%.

Furthermore, Applicants respectfully submit that Example 10 of Burton is a comparative example and is only presented to show the **disadvantages of not including a cortical steroid** in the composition for treating the specific skin disorders of corns, warts, calluses and athlete's foot, see column 1, lines 6-8. As can be seen from column 1, lines 30-32, the ointment of Burton must include the cortical steroid to be effective. This is further evidenced by the fact that the ointment of Example 10, not having the cortical steroid, was totally ineffective. Specifically, Burton states:

> [a]fter six days of treatment, the skin appeared to be loose but the corns remained and the affected area was so sore that treatment could not be continued.

Thus, the comparative Example 10 of Burton is a teaching away from the presently claimed ointment which does not include a cortical steroid.

A reference which leads one of ordinary skill in the art away from the claimed invention cannot render it unpatentably obvious. *Dow Chem. Co. v. American Cyanamid Co.* 816 F2d 617, (CAFC 1987). In determining the scope and content of the prior art, and

determining whether the prior art suggested the claimed invention, the references "must be read as a whole and consideration must be given where the references diverge and teach away from the claimed invention." *Akzo N.V. v. United States Int'l Trade Comm'n*, 1 USPQ2d 1241, 1246 (Fed. Cir. 1986); *In re Fine*, 5 USPQ2d 1596, 1598-99 (Fed. Cir. 1988).

Burton neither teaches nor suggests the use small amount of Aspirin in the base as recited in present independent claim 14, and GB '326 neither teaches nor suggests that Vaseline and/or Hydrocarbon Gel can be used as a base. However, the Examiner has taken the position that it would be obvious to use the concentration range of Aspirin taught by GB '326, 8-13 wt%, (see page 1, lines 76-80) with the Vaseline base of Burton.

Applicants respectfully submit that the skilled artisan would not look to GB '326 for effective modifications to the ointment of Burton, since the GB '326 ointment is used to treat different disorders then the ointment of Burton. GB '326 teaches the ointment is useful in treating psoriasis, acne, seborrheic dermatitis, idiopathic vitiligo and bullous pemphigoid (see page 1, lines 7-10), and Burton teaches the ointment is useful in treating corns, warts, calluses and athlete's foot. Therefore, the skilled artisan would not be motivated to combine these references.

The mere fact it is possible for isolated disclosures to be combined does not render the result of that combination obvious absent a logical reason of record which justifies the combination. *In re Regel et al.* (CCPA 1975) 526 F2d 1399, 188 USPQ 136. To properly combine references to reach a conclusion of obviousness, there must be some teaching, suggestion of inference in either or both of the references, or knowledge generally available to one of ordinary skill in the art, *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Interfer. 1993), which would have led one to combine the relevant teachings of the two references. *Ashland Oil Inc. v. Delta Resins and Refractories, Inc. et al.* (CAFC 1985) 776 F2d 281, 227 USPQ 657. Both the suggestion to make the claimed composition or device or carry out the claimed process and the reasonable expectation of success must be founded in the prior art, not in Applicant's disclosure. *In re Vaeck* (CAFC 1991) 947 F2d 488, 20 PQ2d 1438. The combination is improper if one of the references is non-analogous art. *In re Clay* (CAFC 1992), 23 PQ2d 1058.

In the outstanding Office Action, the Examiner has taken the position that it would be obvious to modify the composition of Example 10 of Burton by reducing the concentration of Aspirin taught in Burton to the concentration of Aspirin taught in GB

'326. Applicants respectfully disagree with the Examiner's position. It would be counterintuitive for the skilled artisan to reduce the concentration of Aspirin in Example 10 of Burton, since even at the high concentration, the ointment of Example 10 is completely ineffective and the affected area was so sore that treatment could not be continued. Thus, the skilled artisan would not be motivated to modify Example 10 of Burton in a manner suggested by the Examiner.

Accordingly, a *prima facie* case of obviousness cannot be said to exist and withdrawal of the rejection is respectfully requested.

[IV] Finality of the Outstanding Office Action

On page 10 of the June 12, 2002 Amendment, Applicants requested that the Examiner sets up an interview prior to the issuance of any further official communications. However, the Examiner made no attempt to set up the interview. Accordingly, an interview had to be made after the issuance of the Final Office Action dated November 27, 2002. Accordingly, withdrawal of the finality of the outstanding Office Action is respectfully requested.

[V] Conclusion

In view of the above amendments and comments, Applicants respectfully submit that the claims are in condition for allowance. However, in the event the Examiner finds to the contrary, Applicants respectfully request that the Examiner enters this Amendment into the official file, for placing the claims in better form for appeal.

Attached hereto is a marked-up version of the changes made to the application by this Amendment.

If the Examiner has any questions concerning this application, he is requested to contact Garth M. Dahlen, Ph.D. (#43,575) at the offices of Birch, Stewart, Kolasch & Birch, LLP.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees

required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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0020-4518P

Attachment: Version with Markings to Show Changes Made
Japanese Pharmaceutical Excipients Reference

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Claims 1-6, 8-10, 15, 17, 19 and 20 have been cancelled.

The claims have been amended as follows:

14. (Twice Amended) An ointment consisting of [acetylsalicylic] acetyl salicylic acid in the range of about 0.001 to 30% by weight per total weight and a base selected from the group consisting of hydrocarbon gel, petrolatum and a mixture thereof without any other additive for said [acetylsalicylic] acetyl salicylic acid and wherein the ointment does not contain water for dissolving said [acetylsalicylic] acetyl salicylic acid.

18. (Amended) The ointment of claim 14, consisting of [acetylsalicylic] acetyl salicylic acid and a base selected from the group consisting of hydrocarbon gel, petrolatum and a mixture thereof without any other additive for destroying the stability of said [acetylsalicylic] acetyl salicylic acid and wherein the ointment does not contain water for dissolving said [acetylsalicylic] acetyl salicylic acid.

Claims 21-25 have been added.